

**REMARKS/ARGUMENTS**

The Office Action rejected all claims 1-20. Independent claims 1, 10, and 17 have been amended herein, and new claims 21-26 are added. For the reasons set forth herein, Applicants respectfully submit that the rejections should be withdrawn.

**Claim 16 – Allowable Subject Matter**

First, Applicants note that claim 16 has not been specifically rejected by the Office Action. Therefore, Applicants assume that claim 16 is presently rejected only for being dependent upon a rejected base claim, and that the subject matter of claim 16 is allowable. Should the Examiner disagree and reject claim 16 in an ensuing Office Action, any such Office Action must be made non-Final, as the rejection of claim 16 would constitute “new grounds” not necessitated by any amendments.

Having said this, this issue is believed to be moot, as Applicants believe that all claims are now in condition for allowance.

**Rejections Under 35 U.S.C. 101**

The Office Action rejected claims 1-9 and 17-20 under 35 U.S.C. § 101 as being non-statutory. In response, independent claims 1 and 17 have been amended to bring them into full compliance with 35 U.S.C. 101. Specifically, claims 1 and 17 have been amended to explicitly recite the relationship between a specific article of jewelry being a member of a larger collection of signature jewelry products, and that such a membership causes a purchaser to correlate the ring with the defined love story theme and signature jewelry collection thereby emphasizing and enhancing the romantic significance of the ring. Support for this

amendment can be found at least on page 8, lines 17-18, and page 11, lines 2-3 of the specification. Because the amended claims now recite useful, tangible, concrete results, the rejection of claims 1-9 and 17-20 under 35 U.S.C. §101 should be withdrawn.

The Office Action has also rejected claims 1-9, 10-15 and 17-20 under 35 U.S.C. § 112, second paragraph as allegedly indefinite. In response to the Examiner's specific questions and notations, claims 1, 10, 11, 12, and 17 were amended. Additionally, new claims 21-26 were added, also in response to the Examiner's specific questions. Minor typographical errors were also addressed in the amendments. Accordingly, the rejection of claims 1-9, 10-15 and 17-20 under 35 U.S.C. § 112, second paragraph should now be withdrawn.

The Office Action further rejected claim 10 under 35 U.S.C. § 112, second paragraph as allegedly incomplete. In response, claim 10 was amended to recite that a presentation folder to be associated with the ring is configured for movement . . . , and claims 23-24 further define how the presentation folder is to be associated with the ring. Accordingly, the rejection of claim 10 under 35 U.S.C. § 112, second paragraph should be withdrawn.

### **Substantive Rejections**

The Office Action has also rejected claims 17-18 under 35 U.S.C. § 103 as allegedly unpatentable over Dialog11027578. This assertion is respectfully traversed. Claims 1, 10 and 17 (as amended) now explicitly recite a relationship between a specific article or ring of jewelry being associated with a larger signature collection of jewelry products. It is requested that the Examiner please consider the commercial significance

and distinctiveness of such an association, and that the Dialog11027578 does not suggest any such feature. For at least this reason, the rejection should be withdrawn.

As a separate and independent basis for traversing the rejection, the Office Action failed to provide adequate motivation for an artisan to modify the Dialog11027578 reference to render obvious the claimed invention. The Office Action's motivational assertion of an obvious relationship between heart designs and "love stories" is spurious and potentially based on a misreading of the specification. In fact, the Office Action never once recites a specific motivational reason in support of the obviousness rejection. Instead, the Office Action merely concludes that the differences are obvious (e.g., Office Action, paragraph 5 states: "it would have been obvious [*sic*] modify the box or other displaying items of DIALOG 11027578 to include love story theme.") **WHY?** It is incumbent on the Office Action to state the reason why.

Simply stated, this reason and rationale advanced by the Office Action is not proper under the prevailing legal standards for rejections under 35 U.S.C. § 103. In this regard, the prevailing legal standards have been developed to prevent nebulous and vague subjective rationales (such as the conclusion that quality would be enhanced) from supporting rejections under 35 U.S.C. § 103. It is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. §103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the

expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(Emphasis added.) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, the Applicant notes that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of providing a method for displaying a ring, as claimed by the Applicants.

"Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed." In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

"A showing of a suggestion, teaching, or motivation to combine the prior art references is an essential component of an obviousness holding." Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed.Cir.2000)) (quoting C.R. Bard, Inc., v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed.Cir.1998)); The Federal Circuit has made it clear "that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); In re Dembiczak, 175 F.3d

994, 999, 50 USPQ2d 1614, 1617 (Fed.Cir.1999). Thus, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant.” In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed.Cir.1998).

For at least the additional reasons set forth above, the rejections under 35 U.S.C. § 103 are misplaced and should be withdrawn.

Further, none of the references in the Dialog11027578 reference disclose or suggest including an abbreviated version of a time-honored romantic classic stories (thus “defined”) such as the five famous stories suggested in the specification. In this way, the claimed “**defined** love story theme” (emphasis added) has a specific connotation supported in the specification which differs substantially from the Office Action’s ambiguous, vague, and entirely **undefined** term “love stories”.

Furthermore, the “secret box” of the Dialog11027578 reference is explicitly described as being a repository for storing “mementos” and “sentimental trophies” on the bride and groom’s “special day”. Such items would not fit in the claimed ring box. Also, the mementos and trophies of Dialog11027578 originate from third parties not privy to the original ring-giving transaction. Conversely, within the claimed invention, all items in the claimed box are romantic and personal gifts from a purchaser of the ring to a recipient only (a 2-party transaction). Within the present invention, no third parties items are disclosed or suggested for placement within the claimed box. Also, it is not absolute that the present invention be limited to a bride/groom environment, as is clearly the case with the Dialog11027578 reference. Claims 1, 10, and 17 have been amended

to explicitly recite a purchaser and recipient. Accordingly, the rejection of 17-18 under 35 U.S.C. § 103 should be withdrawn.

The Office Action further rejected claims 1-9, 10-15, and 19-20 under 35 U.S.C. § 103 as allegedly unpatentable over Dialog 11027578 in view of Dialog 13117692. As stated, claims 1, 10 and 17 (as amended) now explicitly recite a relationship between a specific article or ring of jewelry being associated with a larger signature collection of jewelry products. This amendment by itself is sufficient to overcome the above rejection of claims 1-9, 10-15, and 19-20 under 35 U.S.C. § 103, which should now accordingly be withdrawn.

#### **CONCLUSION**

In view of the foregoing, it is believed that all pending claims are in proper condition for allowance. If the Examiner believes that a telephone conference would expedite the examination of the above-identified patent application, the Examiner is invited to call the undersigned.

No fee is believed to be due in connection with this amendment and response to Office Action. If, however, any fee is believed to be due, you are hereby authorized to charge any such fee to deposit account No. 20-0778.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Daniel R. McClure', written over a horizontal line.

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